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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,627	10/01/2001	Masakazu Karita	31.001-AG	2280

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JUDGE PATENT FIRM
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JAPAN

EXAMINER

SZMAL, BRIAN SCOTT

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/682,627

Applicant(s)

KARITA, MASAKAZU

Examiner

Brian Szmaj

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 8-36 is/are pending in the application.
- 4a) Of the above claim(s) 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 8, 9, 12-24, 26-28 and 35 is/are rejected.
- 7) ☒ Claim(s) 25, 29-34 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on September 29, 2000. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b). Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on April 2, 2001. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Claim Objections

3. Claims 25, 29-34 and 36 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-5, 8, 9, 12-24, 26-28 and 35 are rejected under 35 U.S.C. 101 because the claimed invention lacks credible utility. The above claims lack credible asserted utility for the following reasons: The claims lack credible asserted utility because there is not any support within the current state of the art to support the current magnetic device obtaining the claimed results. Furthermore, the use of an insertion body inside the center of the device, a print of a picture that is burned and the ashes are placed inside

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the center of the device, recording sound, listening to the sound, purifying water using the insertion body, bathing in water containing the insertion body, or burning the print near any type of food, as claimed in Claim 28, and either consuming the food or placing the food on the body does not provide any health benefits that are supported by accepted modern scientific principles. The utilization of the device to influence the power consumption, as claimed in Claims 23 and 24, and using the device in conjunction with an internal combustion engine, as claimed in Claim 35, are also not supported by modern scientific principles. Since the above claimed matter is not supported by the current state of the art scientific principles, the above elements constitute a lack of credible asserted utility. See, *Brenner v. Manson*, 383 U.S. 519, 534-35, 148 USPQ 689, 695 (1966); *Newman v. Quigg*, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); *In re Harwood*, 390 F.2d 985, 989, 156 USPQ 673, 676 (CCPA 1968); *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992); *In re Citron*, 325 F.2d 248, 253, 139 USPQ 516, 520 (CCPA 1963); *In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977); *Fregeau v. Mossinghoff*, 776 F.2d 1034, 227 USPQ 848 (Fed. Cir. 1985); *In re Ruskin*, 354 F.2d 395, 148 USPQ 221 (CCPA 1966); and *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967).

One situation where an assertion of utility would not be considered credible is where a person of ordinary skill would consider the assertion to be "incredible in view of contemporary knowledge" and where nothing offered by the applicant would counter what contemporary knowledge might otherwise suggest. (MPEP 2107.02 (III. B.))

Independent claims 2 and 3 are included in the current rejection because the sole basis of the current independent claims is to provide a device structure that provides incredible utilities, as claimed by the Applicant.

Response to Amendment

5. The declaration under 37 CFR 1.132 filed October 15, 2003 is insufficient to overcome the rejection of claims 13-18, 21, 22, 26-28 based upon the lack of patentable utility as set forth in the last Office action because: The current Applicant attesting to the credible utility provided the declaration, however, since the applicant is making the declaration, the declaration lacks probative weight because the Applicant is not a disinterested person. An affidavit of an applicant as to the advantages of his or her claimed invention, while less persuasive than that of a disinterested person, cannot be disregarded for this reason alone. *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna*, 203 F.2d 717, 97 USPQ 348 (CCPA 1953). Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). See also MPEP 2107.02, 716, 716.01 (c), and 716.08. In order for a declaration attesting to the utility of the current invention to have more probative weight, a person who does not have any interest and investment in the current

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application would have to declare the utility of the current invention. Since the Applicant has a personal interest and an investment in the current invention, and in light of the claimed subject matter, the submitted declaration does not overcome the current lack of utility rejection.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited art of Epstein et al disclose a magnetic brain stimulation system using ferromagnetic material wrapped with a copper coil but does not disclose the position of the magnetic poles in relation to the bar magnets and also utilize electricity to energize the coil.

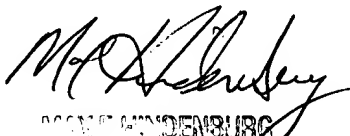
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Szmalec whose telephone number is (703) 308-3737. The examiner can normally be reached on Monday-Friday, with second Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-2701. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


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